



IFW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of :

KAI FABIAN et al.

Examiner: Shawquia Young

Serial No.: 10/525,820

Group Art Unit: 1626

Filed: February 25, 2005

For: PROCESS FOR THE PREPARATION OF MONOALKYLAMINOKETONES

RESPONSE TO REQUIREMENT FOR RESTRICTION

MAIL STOP AMENDMENT
Commissioner for Patents
Box 1450
Alexandria, Virginia 22313-1450

SIR:

In response to the Office Action mailed April 14, 2006, and the restriction requirement set forth therein, Applicants hereby elect Group II, claims 1-9, 11, 12 and 12, drawn to compounds of the formula I of claim 1, wherein R¹ is thienyl. The election is made with traverse for the reasons set forth below. Applicants reserve the right to file one or more divisional applications directed to the non-elected subject matter.

Applicants respectfully urge that the full scope of the claims have unity of invention and should not be subject to restriction. All of the claims depend ultimately from claim 1 and all of the claims share the special technical feature of the base compound of formula I of claim 1. The compounds of claim 1 are a "special technical feature" which defines a contribution over the prior art. Claims 2 and 4-11 relate to a process for making the compound of claim 1 which is a single general process. Note that all of these claims depend, at least in part from claim 2. (Claim

3 contains an error and will be amended when making a reply on the merits.)

The Office Action alleges that the compounds of formula I do not define a special technical feature which is a contribution over the prior art. However, this allegation is merely a conclusory statement and no proof is provided that the feature fails to define a contribution over the prior art.

The Office Action further alleges that the substituents for the formula vary extensively and result in vastly different compounds. Applicants respectfully disagree. The formula contains only two variables. The R^1 variable is limited to heterocyclic radicals and the R^2 variable is limited to alkyl groups. The relatively broader – but still not very broad – listing of variables for the R^3 and R^4 groups merely relates to the optional substituents on the cyclic R^1 group. These substituent groups do not vastly change the base structure of the resulting compounds. Applicants urge that in view of the existing prior art in this field, the scope of this claim is quite modest and the resulting compounds are not "vastly different compounds." All of the compounds have the specific requirements of the cyclic R^1 group bonded through a carbonyl group to an alkylaminoethylene chain. No evidence has been provided to meet the PTO's burden to show that this core structure does not define a constitution over the prior art. All of the compounds share this common structural core and this common structural core is disclosed in the specification as providing the compounds the shared utility as intermediates for useful medicaments. Accordingly, applicants urge that the claims define a proper Markush group which has unity of invention.

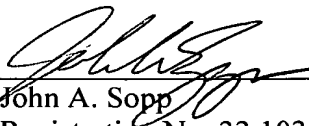
If the issue is alleged indefiniteness of the cyclic and aryl substituent terms, applicants would consider using the definitions of the specific cyclic R^1 groups at pages 4-5, and the

specified aryl and aryloxy groups at page 6. This would make the definition of the compounds quite specific.

For all of the above reasons, it is urged that the restriction requirement should be withdrawn. Favorable action is earnestly solicited.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,


John A. Sopp
Registration No. 33,103
Attorney for Applicants

MILLEN, WHITE, ZELANO
& BRANIGAN, P.C.
Arlington Courthouse Plaza I
2200 Clarendon Blvd. Suite 1400
Arlington, Virginia 22201
Telephone: (703)243-6333
Facsimile: (703) 243-6410
Attorney Docket No.: MERCK-2979

Date: May 12, 2006